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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,181	06/19/2001	Octavian Anton	P66718US0	8973

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

**Office Action Summary**

Application No.

09/857,181

Applicant(s)

ANTON ET AL

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Withdrawn Rejections*

1. The obviousness double patenting rejection is repeated for the reasons previously of record in Paper #5, Page 2, Paragraph #2.

Claims 1 – 4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 7 of copending Application No. 09/857,182. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications disclose the same invention in the claims the difference being that one of the applications goes into greater detail in the claims concerning the claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. The 35 U.S.C. 103 rejection of claims 5 and 6 over Kratel et al. in view of Takahashi et al. is repeated for reasons previously of record in Paper #8, Pages 2 – 4, Paragraph #6.

Kratel et al. discloses a microporous heat insulating board that contains 30 to 100% by weight of finely divided metal oxide, 0 to 50% by weight of an opacifier, 0 to 15% of an organic binder and 0 to 50% by weight of a fibrous material (Column 4, claim 1). However, Kratel et al. fails to disclose 2 to 45% or 5 to 15% of xonotlite present in the heat insulating board.

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Takahashi et al. teaches 2 to 60% (Column 7, lines 30 – 34) of xonotlite (Column 21, lines 59 – 61), 21 to 70% of an inactive substance (Column 5, lines 53 – 55) which includes metal oxides (Column 5, lines 31 – 40) and other additives such as fibers and binders (Column 7, lines 51 – 53) in an insulation board for the purpose of forming a board that is light weight, has excellent insulating properties over a wide range of temperatures and has high fire resistance.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the xonotlite as a component in Kratel et al. in order to form a board that is light weight, has excellent insulating properties over a wide range of temperatures and has high fire resistance as taught by Takahashi et al.

Regarding the heat insulation bodies being manufactured by dry compressing in claim 1, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of dry compressing is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the

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Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

3. The 35 U.S.C. 103 rejection of claims 5 and 6 over Kratel et al. in view of Takahashi et al. and Sklarski et al. is repeated for reasons previously of record in Paper #8, Pages 4 - 5, Paragraph #7.

Kratel et al., as modified with Takahashi et al., discloses the claimed invention above except for at least one or both sides of the core having a cover of a heat-resistant material, characterized in that the cover are the same or different and at least one side consists of pre-compressed xonotlite, mica or graphite, the cover consists of a prefabricated mica sheet on both surfaces.

Sklarski et al. teaches binder being impregnated in a mica paper or papers (Column 1, lines 47 – 52) before placed under heat and pressure (Column 6, lines 33 – 35) in a laminate for the purpose of forming a insulating structure with excellent flexibility, higher moisture resistance and more strength that can be used as supporting insulation for high temperature thermostats, control devices, strip heaters and baseboard heaters.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a layer of mica sheets as cover sheets in the modified

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Kratel et al. in order to forming a insulating structure with excellent flexibility, higher moisture resistance and more strength that can be used as supporting insulation for high temperature thermostats, control devices, strip heaters and baseboard heaters as taught by Sklarski.

***Response to Arguments***

4. Applicant's arguments filed in Paper #10 regarding the 35 U.S.C. 103 rejection of claims 5 and 6 over Kratel et al. in view of Takahashi et al. have been fully considered but they are not persuasive.

In response to Applicant's argument that the present invention is manufactured by dry compressing, no weight is given to process limitation in the claim since it a product by process claim. The references, as disclosed, teach the structure of the claimed invention.

In response to Applicant's argument that Kratel et al. and Takahashi et al. does not include certain features of the Applicant's invention, the limitations on which the Applicant's relies (i.e. products containing pyrogenic silica crack upon drying when a wet formation is process is applied) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specification that anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ 2d 1064.

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5. Applicant's arguments filed in Paper #10 regarding the 35 U.S.C. 103 rejection of claims 7 – 9 over Kratel et al. in view of Takahashi et al. and Sklarski et al. have been fully considered but they are not persuasive.

In response to Applicant's argument that Kratel et al. and Takahashi et al. does not include certain features of the Applicant's invention, the limitations on which the Applicant's relies (i.e. the binders in the heat insulation body being heat stable up to temperatures of 1000 °C) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specification that anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ 2d 1064.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

November 20, 2002

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772* *11/25/02*